

### **REMARKS**

The Office Action dated September 25, 2008 has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 1, 10, 11 and 20 have been amended to more particularly point out and distinctly claim the subject matter of the invention. Claims 6, 16, and 17 have been cancelled without prejudice and/or disclaimer. Claims 23-30 have been added. No new matter is believed to have been added. Claims 1, 4, 5, 7-11, and 20-30 are currently pending and are respectfully submitted for consideration.

Reconsideration and withdrawal of the objections and rejections is respectfully requested in light of the following remarks.

Claims 10, 11, 16, 17, and 20 were rejected under 35 U.S.C. §101 for being directed to non-statutory subject matter. More particularly, the Office Action alleged the term “controller entity” recited in claims 10, 11, 16, 17, and 20 are directed to a computer program. However, Applicants respectfully traverse this rejection as follows.

Claim 10 has been amended to recite “controller” instead of “controller entity”, thereby adding further structural support to the claims. As such, Applicants respectfully submit that the Office Action can no longer rely on the term “entity” as being part of a computer program. Therefore, Applicants respectfully request that the rejection of claim 10 be withdrawn.

Claims 16 and 17 have been cancelled, and, therefore the rejection with respect to claims 16 and 17 is moot.

Furthermore, with respect to the rejection of claims 11 and 20, Applicants respectfully submit that the Office Action incorrectly rejected independent claims 11 and 20 under 35 U.S.C. § 101. More particularly, the term “controller entity” is not recited in claims 11 and 20 and, therefore the Office Action incorrectly rejected claims 11 and 20 under 35 U.S.C. § 101. Accordingly, Applicants respectfully request that the rejection of claims 11 and 20 be withdrawn.

Claims 1, 4-11, 16, 17, and 20-22 were rejected under 35 U.S.C. §112, second paragraph, for being indefinite. More particularly, the Office Action asserted that the recitation “request is to be forked in parallel or sequentially” in claim 1, line 8 is not clear. Claims 10, 11, 17, 20, and 22 were rejected upon a similar ground. Applicants respectfully traverse this rejection as follows.

MPEP § 2173.02 states that:

[i]n reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the **examiner must consider the claim as a whole** to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent.

In this case, when construing, for example claim 1 as a whole together with paragraph [0031] of the specification it is clear what “request is to be forked in parallel or sequentially” means. Particularly, claim 1 recites “a request [is received] at the controller

for a communication link to the user”, “... a database [is queried] for information regarding ... how to handle the request”. This “information indicat[es] if said request is to be forked in parallel or sequentially” (claim 1, lines 6-7). Therefore, in light of the above, it would be clear to one of ordinary skill in the art when construing claim 1 together with paragraph [0031] of the specification what the recitation “request is to be forked in parallel or sequentially” means. Therefore, because the recitations in claims 1, 10, 11, 20, and 22 would be clear to a person of ordinary skill in the art, Applicants respectfully request that the rejection of claims 1, 10, 11, 20, and 22 be withdrawn.

With respect to the rejection of claim 17, Applicants respectfully submit that the rejection of claim 17 is moot, because claim 17 has been cancelled.

The Office Action also asserted that the recitation “registration means”, “interface means”, and “query means” in claim 20 is unclear as to what this refers to. In other words, the Office Action asserts that a person of ordinary skill in the art would not understand the meaning of “registration means”, “interface means”, and “query means”. Applicants respectfully traverse this rejection as follows.

MPEP § 2181(II) states:

35 U.S.C. 112, sixth paragraph states that a claim limitation expressed in means-plus-function language "shall be construed to cover the corresponding structure described in the specification and equivalents thereof."

The proper test for meeting the definiteness requirement is that the corresponding structure (or material or acts) of a means (or step)-plus-function limitation must be disclosed in the specification itself in a way

that one skilled in the art will understand what structure (or material or acts) will perform the recited function.

The disclosure of the structure (or material or acts) may be implicit or inherent in the specification if it would have been clear to those skilled in the art what structure (or material or acts) corresponds to the means (or step)-plus-function claim limitation. See *Id.* at 1380, 53 USPQ2d at 1229; *In re Dossel*, 115 F.3d 942, 946-47, 42 USPQ2d 1881, 1885 (Fed. Cir. 1997).

In this case, the test for meeting the definiteness requirement is met, because paragraph [0028] of the present specification clearly discusses the corresponding structure of, for example, a registration means in a way that a person of ordinary skill in the art will understand what structure will perform the recited functions. As such, other paragraphs of the specification also discuss the corresponding structure of “interface means”, and “query means”. Therefore, the scope of the recitations of claim 20 would be clear to a person of ordinary skill in the art.

Accordingly, Applicants respectfully request that the rejection of claim 20 be withdrawn for at least the reasons stated above.

Claims 1, 4-11, 16, 17, and 20-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sanchez Herrero et al. (U.S. Patent No. 7,177,642) (“Herrero”) in view of Costa-Requena et al. (U.S. Patent No. 7,028,101) (“Requena”). Particularly, the Office Action asserted that the combination of Herrero and Requena disclosed all of the elements of claims 1, 4-11, 16, 17, and 20-22. However, this rejection is respectfully traversed as followed.

Applicants note that Requena was assigned to Nokia Corporation. The above-identified application is assigned to Nokia Corporation. As such, Requena is disqualified as prior art under 35 U.S.C. § 103(c). 35 U.S.C. § 103(c)(1) states, in part, “[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.” (Emphasis added). For the purposes of United States law, a “person” may be a corporation. The only section of 35 U.S.C. § 102 that Requena potentially qualifies under is 35 U.S.C. § 102(e), as the publication date of Requena was after the filing date of the above-identified application. Further, Requena was under an obligation of assignment to Nokia at the time the claimed invention was made. Thus, Requena does not qualify as prior art per 35 U.S.C. § 103(c), and the rejection is improper and must be withdrawn. As such, the outstanding Office Action must be withdrawn and a new Office Action must be issued.

However, in an attempt to further advance prosecution of the above-identified application, Applicants submit that following comments to overcome the rejection under 35 U.S.C. § 103(a).

Claim 1, upon which claims 4, 5, 7-9, 21, and 23 are dependent, recites a method. The method includes registering in a controller entity a plurality of contact addresses for

a user. The method includes receiving a request at the controller entity for a communication link to the user. The method includes querying by the controller entity a database for information regarding a manner regarding how to handle the request. The information indicating if the request is to be forked in parallel or sequentially. The method includes processing the request in accordance with the information from the database. The processing occurs in accordance with the information from the database if no user preference has been indicated for the known contact addresses. The user preference indicating if a request is to be forked in parallel or sequentially.

Claim 10, upon which claim 24 is dependent, recites a system. The system includes a multimedia network provided with a controller configured to register contact addresses of a user. The system includes a database configured to store information regarding a manner regarding how to handle a request for the user, the information indicating if the request is to be forked in parallel or sequentially. The controller is configured to query the user information storage and configured to process requests for connections to the user in accordance with the information queried from the database. The controller is further configured to process a request for a connection in accordance with the information from the database if no user preference has been indicated for the known contact addresses. The user preference indicating if a request is to be forked in parallel or sequentially.

Claim 11, upon which claims 25-30 are dependent, recites an apparatus. The apparatus includes a register configured to register a plurality of contact addresses for a user. The apparatus includes an interface to a database configured to store information regarding a manner regarding how to handle a request for the user. The apparatus includes a querying unit configured to query the database. The apparatus includes a processor configured to process requests for connections to the user in accordance with the information from the database. The information indicating if the request is to be forked in parallel or sequentially. The processor is configured to process a request for a connection in accordance with the information from the database if no user preference has been indicated for the known contact addresses. The user preference indicating if a request is to be forked in parallel or sequentially.

Claim 20 recites an apparatus. The apparatus includes a registration means for registering a plurality of contact addresses for a user. The apparatus includes an interface means for interfacing to a database means for storing information regarding how to handle a request for the user. The apparatus include a querying means for querying the database means for information regarding a manner regarding how to handle the request. The apparatus includes a processing means for processing the request in accordance with the information from the storage means. The information indicating if the request is to be forked in parallel or sequentially. The processing means is configured to process the request in accordance with the information from the storage means if no user preference

has been indicated for the known contact addresses. The user preference indicating if a request is to be forked in parallel or sequentially.

Claim 22 recites a method. The method includes registering in a serving call session control function a plurality of contact addresses for a user. The method includes receiving a request at the serving call session control function for a communication linked to the user. The method includes querying a database for information regarding a manner as to how to handle the request. The information indicating if the request is to be forked in parallel or sequentially. The querying being performed if no preferences for forking has been indicated in the registering. The method includes processing the request in accordance with the information from the database.

By at least the aforementioned features of the independent claims, because the information indicates whether the request is to be forked in parallel or sequentially, the request can be process in accordance with the information when no user preference has been indicated.

As will be discussed below, Applicants respectfully submit that the combination of Herrero and Requena fails to disclose, either expressly or implicitly, all of the elements of the claims, and therefore fail to provide the advantages and features discussed above.

Herrero generally discusses a method and system for handling multiple registration. In particular, Herrero discusses supporting multiple registration from the same user requested from different terminals in a telecommunications system requiring to



manage information related to the location of said user and related to the plurality of identifiers that identify said user in said system. See Herrero, Abstract.

However, Applicants respectfully submit that Herrero does not disclose, either expressly or implicitly, at least, “receiving a request...for a communication link to the user; [and] querying...a database for information...regarding how to handle the request”, as recited in claims 1, and as similarly recited in claims 10, 11, 20, and 22. Instead, the section of Herrero, which was relied upon in the Office Action, discusses that once the registration of a 2G or 3G user has run successfully, the user can receive incoming sessions...on his/her terminal from other users. See Herrero, column 2, lines 5-7. Another section of Herrero, which was relied upon in the Office Action, discusses that once the registration request REGISTER arrives to the I-CSCF, in step 3 a query is made to the HSS to determine the user registration status CX-Query. See Herrero, column 10, lines 40-45.

Applicants respectfully submit that the above-mentioned sections Herrero, which were cited in the Office Action, cannot be construed to disclose, either expressly or implicitly, the above-quoted features of claim 1, for example, because column 2, lines 5-7 of Herrero discusses what happens after the user has registered and column 10, lines 40-45 of Herrero discusses what happens prior to registration. As such, a combination of these two sections could not produce a working model of the claimed invention. For example, the combination of the sections of Herrero would not suggest “receiving a

request...for a communication link to the user; [and] querying...a database for information...regarding how to handle the request” (emphasis added), as recited in claims 1, and as similarly recited in claims 10, 11, 20, and 22. Because Herrero does not disclose the above-quoted features of claims 1, 10, 11, 20, and 22, Herrero cannot suggest how to “process the request in accordance with the information from the database...”, as recited in claim 1, and as similarly recited in claims 10, 11, 20, and 22.

With respect to the limitation “said information indicating if said request is to be forked in parallel or sequentially”, the Office Action conceded that Herrero fails to disclose such a limitation. Instead, the Office Action relied upon column 13, lines 28-32 of Requena to teach the above-quoted limitation. However, Applicants respectfully submit that Requena does not teach the above-quoted limitation recited in claim 1, and as similarly recited in claims 10, 11, 20, and 22.

Requena generally discusses an optimal location service for managing next hop addressing for message associated with multiple address schemes. More particularly, Requena discusses a manner of managing next hop addressing where multiple address schemes are provided in messages transmitted via a network. See Requena, column 1, lines 8-11. According to Figure 6 of Requena, the OLS determines whether multiple address schemes are associated with a received response from the DNS. See Requena, column 13, lines 36-38. If multiple addresses were associated with the response, the OLS

can sequentially and/or simultaneously send multiple outgoing messages, one for each of the multiple address returned. See Requena, column 13, lines 45-50.

In other words, Requena simply discusses sending out sequential and/or simultaneous outgoing messages when a multiple address scheme is associated with the response received from the DNS. However, in no way does the above-mentioned discussion of Requena suggest “information indicating [the] request is to be forked in parallel or sequentially” (claim 1) with respect to a “query...[on] how to handle the request” (claim 1) so the request can be processed in accordance with the information “if no user preference has been indicated for the known contact addresses” (claim 1).

Therefore, in view of the above, not only does Requena fail to teach the above-quoted limitation, which was relied upon by the Office Action, but also fails to cure the above-mentioned deficiencies of Herrera, as discussed above with respect to claims 1, 10, 11, 20, and 22.

Thus, Applicants respectfully request that the rejection of independent claims 1, 10, 11, 20, and 22 be withdrawn and these claims be allowed for at least the reasons stated above. Furthermore, Applicants respectfully request that the rejection of dependent claims 4-9 and 21 be withdrawn and these claim be allowed for at least the same reasons as their respective base claims, from which they depend upon, and for the specific limitations recited therein.

New claim 23, which depends upon claim 1, recites that the processing occurs in accordance with the information from the database if the request does not comprise any caller preferences, the caller preferences indicating if a request is to be forked in parallel or sequentially. However, Applicants respectfully submit that nothing was found in the cited documents that discloses, either expressly or implicitly, the above-mentioned features of claim 23. Therefore, Applicants respectfully request that claim 23 be allowed for at least the same reasons as base claim 1, and for the specific limitations recited therein.

New claim 24, which depends upon claim 10, recites that the controller is further configured to process a request for a connection in accordance with the information from the database if the request does not comprise any caller preferences, the caller preferences indicating if a request is to be forked in parallel or sequentially. However, Applicants respectfully submit that nothing was found in the cited documents that discloses, either expressly or implicitly, the above-mentioned features of claim 24. Therefore, Applicants respectfully request that claim 24 be allowed for at least the same reasons as base claim 10, and for the specific limitations recited therein.

New claim 25, which depends upon claim 11, recites that the processor is configured to process a request for a connection in accordance with the information from the database if the request does not comprise any caller preferences, the caller preferences indicating if a request is to be forked in parallel or sequentially. However, Applicants

respectfully submit that nothing was found in the cited documents that discloses, either expressly or implicitly, the above-mentioned features of claim 25. Therefore, Applicants respectfully request that claim 25 be allowed for at least the same reasons as base claim 11, and for the specific limitations recited therein.

New claim 26, which depends upon claim 11, recites that the apparatus is provided in association with a multimedia network. However, Applicants respectfully submit that nothing was found in the cited documents that discloses, either expressly or implicitly, the above-mentioned features of claim 26. Therefore, Applicants respectfully request that claim 26 be allowed for at least the same reasons as base claim 11, and for the specific limitations recited therein.

New claim 27, which depends upon claim 11, recites that the register is configured to register the plurality of contact addresses in at least two different communication networks. However, Applicants respectfully submit that nothing was found in the cited documents that discloses, either expressly or implicitly, the above-mentioned features of claim 27. Therefore, Applicants respectfully request that claim 27 be allowed for at least the same reasons as base claim 11, and for the specific limitations recited therein.

New claim 28, which depends upon claim 11, recites that the querying unit is configured to apply a query to a sub-group of the known contact addresses. However, Applicants respectfully submit that nothing was found in the cited documents that discloses, either expressly or implicitly, the above-mentioned features of claim 28.

Therefore, Applicants respectfully request that claim 28 be allowed for at least the same reasons as base claim 11, and for the specific limitations recited therein.

New claim 29, which depends upon claim 11, recites that the apparatus includes a receiver configured to receive handling instructions for at least one contact address during registration of the at least one contact address. However, Applicants respectfully submit that nothing was found in the cited documents that discloses, either expressly or implicitly, the above-mentioned features of claim 29. Therefore, Applicants respectfully request that claim 29 be allowed for at least the same reasons as base claim 11, and for the specific limitations recited therein.

New claim 30, which indirectly depends upon claim 11, recites that the receiver receives the handling instructions from either the user or the database. However, Applicants respectfully submit that nothing was found in the cited documents that discloses, either expressly or implicitly, the above-mentioned features of claim 30. Therefore, Applicants respectfully request that claim 30 be allowed for at least the same reasons as base claim 11, and for the specific limitations recited therein.

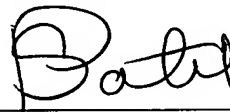
For at least the reasons discussed above, Applicants respectfully submit that none of the cited references, whether considered alone or in combination, disclose, either expressly, implicitly or inherently, all of the elements of the claimed invention. These distinctions are more than sufficient to render the claimed invention unanticipated and

unobvious. It is therefore respectfully requested that all of claims 1, 4, 5, 7-11, and 20-30 be allowed, and this application passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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Sheetal S. Patel  
Attorney for Applicants  
Registration No. 59,326

**Customer No. 32294**  
SQUIRE, SANDERS & DEMPSEY L.L.P.  
14<sup>th</sup> Floor  
8000 Towers Crescent Drive  
Vienna, Virginia 22182-6212  
Telephone: 703-720-7800  
Fax: 703-720-7802

SSP:dk